Appl. No. 09/774,439
Amdt. dated December 16, 2004
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2153

PATENT

REMARKS/ARGUMENTS

Amendments

Applicant amended three figures in the response to the first Office Action. The final Office Action does not indicate whether these amendments were accepted or not. It has been discovered that the new Fig. 4 submitted in that amendment was done so by mistake. The Examiner is requested to not enter the amendment to Fig. 4, but to consider the amendments to Figs. 7 and 12 previously submitted. Applicant apologizes for any inconvenience this may have caused the Office.

35 U.S.C. §102/§103 Rejection, Donaldson / Pace et al.

The Office Action has rejected claims 1-9, 11 and 13-16 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent No. 6,321,267 to Donaldson (hereinafter "Donaldson"). The Office Action has rejected claims 10, 12 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over Donaldson in view of the cited portions of U.S. Patent No. 6,460,050 to Pace et al. (hereinafter "Pace").

Applicant largely reiterates the argument presented in the response to the first Office Action and urges the Office to reconsider the interpretation of Donaldson presented in the office actions. Specifically, Applicants believe major limitations from claims 1, 11 and 17 are neither taught nor suggested in Donaldson. More specifically, Donaldson cannot be relied on to teach or suggest the following limitations generally included in all claims: (1) checking for addresses in routing information of a header of the electronic mail message to determine a facilitating party, or (2) "*automatically* reporting information relating to the electronic mail message to the facilitating party." Applicants respectfully request that the rejections be withdrawn for these reasons.

First Missing Limitation: Header Check

The final Office Action seems to take a position that the SMTP protocol fields include the message header in an attempt to show that Donaldson uses header information when

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rejecting a message. Final Office Action, page 2, second paragraph, middle two sentences. This interpretation is not supported by Donaldson. Donaldson indicates what is meant by the term "header" to include routing information portion of the message. Donaldson, Fig. 3. Donaldson touts the ability to reject a message based upon the protocol level handshake before receiving the header. Donaldson, col. 8, lines 29-44; and col. 17 through col. 18, line 2. The protocol level handshake is described as an exchange of IP address of the mail sender. Id., col. 8, lines 18-29; Fig. 2, steps 1010-1015; col. 17, lines 1-7. Before the message (including header) is received, the message can be rejected based upon the protocol level handshake. Fig. 2, step 1020; col. 18, lines 1-2.

In some embodiments, the present application does prescreening based upon the protocol-level handshake. Application, page 12, lines 10-13; Fig. 5C, step 528. The message header can be also checked in these embodiments (as is claimed). Donaldson simply does not perform such a check of the header and attempts to base all decisions on the protocol-level handshake information.

The flaw of applying Donaldson in any rejection is best illustrated by claims 6, 13 and 19, which requires both a protocol-level check and a header check. The same sections of Donaldson are cited for both of these propositions. The only way this makes sense is that Donaldson is misapplied to checking the header information. Reconsideration is respectfully requested.

Second Missing Limitation: Automatic Notification

The final Office Action takes the position that Donaldson teaches automatic notification of the facilitating party. Final Office Action, page 4, fourth paragraph from the bottom of the page. This interpretation of Donaldson goes too far. Donaldson appears to teach manual notification where the "recipients complain." Donaldson, col. 5, lines 7-11. Unlike the automated process claimed, Donaldson requires individuals to take the effort to report spam to facilitating parties. Even Donaldson criticizes this type of manual notification. Id., col. 5, lines 10-11. Reconsideration is requested.

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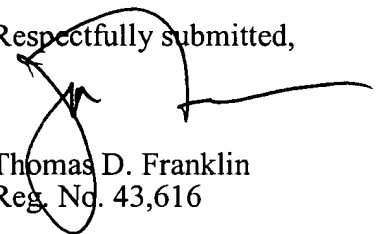Amendment under 37 CFR 1.116 Expedited Procedure
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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